

UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office  
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Washington, D.C. 20231

SERIAL NUMBER	REQUEST DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
10/689,452	9/15/04	JACK HOSKING, ET AL.	1425.67029

Title: **RAIL FASTENER DRIVER WITH ENHANCED  
FASTENER POSITIONING**

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Art Unit	Paper Number
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Correspondence Address:

LAWRENCE J. CRAIN  
GREER, BURNS & CRAIN, LTD.  
300 SOUTH WACKER DRIVE  
SUITE 2500  
CHICAGO, ILL. 60606

Licensee under 35 U.S.C. 184 is hereby granted to file in any foreign country a patent application and any amendments thereto corresponding to the subject matter of this U.S. application identified above and/or any material accompanying the petition. This license is conditioned upon modification of any applicable secrecy order and is subject to revocation without notice.

License Number: 536,800  
Grant Date: 08-Aug-06

**This license is granted retroactively to  
the date(s) and the country(s) indicated  
on the attached decision.**

Approved:

  
for Commissioner of Patents and Trademark

This license empowers the filing, the causation and the authorization of the filing of a foreign application or applications on the subject matter identified above, subsequent forwarding of all duplicate and formal papers and the prosecution of such application or applications.

This license does not empower the filing of any applications, amendments, supplements or continuances originating in this country which disclose inventions, modifications, or variations not disclosed in the subject matter identified above.

This license is to be retained by the licensee and may be used at anytime on or after the date thereof. This license is not retroactive unless specifically indicated.

The grant of this license does not in any way lessen the responsibility of the licensee for the security of the subject matter as imposed by any Government contract or the provisions of existing laws relating to espionage and the national security or the export of technical data. Licensees should apprise themselves of current regulations, especially with respect to certain countries, of other agencies, particularly the Office of Foreign Assets Control, Department of the Treasury; Office of Munitions Control, Department of State (with respect to Arms, Munitions and Implements of War); the Bureau of Trade Regulation, Office of Export Administration, Department of Commerce; and the Department of Energy.

**LICENSE FOR FOREIGN FILING**

[Title 35, United States Code (1952) Sections 184, 185, 186]



UNITED STATES PATENT AND TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND  
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE  
WASHINGTON, DC 20231  
www.uspto.gov

Lawrence J. Crain  
GREER, BURNS & CRAIN, LTD.  
300 South Wacker Drive  
Suite 2500  
Chicago, IL 60606

In re: Hosking et al : DECISION ON REQUEST  
Serial No.: 10/689,452 : UNDER 37 CFR 5.25  
Filing date: 20 October 2003  
Docket No: 1425.67029

Title: RAIL FASTENER DRIVER WITH ENHANCED FASTENER POSITIONING

In view of the communication(s) filed 20 December 2005, it has been determined that a retroactive license for foreign filing under 35 U.S.C. 184 be granted with respect to the filings listed below. The petition complies with 37 C.F.R. 5.25 in that there is an adequate showing that the subject matter in question was not under secrecy order, that the license was diligently sought after discovery of the proscribed foreign filing, and that the material was filed abroad without the required license under 37 C.F.R. 5.11 first having been obtained through error and without deceptive intent.

Country

Date

Canada

20 October 2003

Approved:

Andrea M. Valenti  
Patent Examiner  
Group 3643  
(571)272-6895

09 August 2006



UNITED STATES PATENT AND TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND  
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WASHINGTON, DC 20231  
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Lawrence J. Crain  
GREER, BURNS & CRAIN, LTD.  
300 South Wacker Drive  
Suite 2500  
Chicago, IL 60606

In re: Hosking et al : DECISION ON REQUEST  
Serial No.: ~~10/689,462~~ 10/689,452 : UNDER 37 CFR 5.25  
Filing date: 20 October 2003  
Docket No: 1425.67029

Title: RAIL FASTENER DRIVER WITH ENHANCED FASTENER POSITIONING

This is a decision on the petition response filed 11 April 2005 for the petition for retroactive foreign filing license filed on 16 September 2004 and subsequent to the decision mailed 22 March 2005.

37 CFR 5.25(a) requires the following:

1. A listing of each of the foreign countries in which the unlicensed patent application material was filed,
2. The dates on which the material was filed in each country,
3. A verified statement (oath or declaration) containing:
  - i. An averment that the subject matter in question was not under a secrecy order at the time it was filed abroad, and that it is not currently under a secrecy order,
  - ii. A showing that the license has been diligently sought after discovery of the proscribed foreign filing, and
  - iii. An explanation of why the material was filed abroad through error and without deceptive intent without the required license under § 5.11 first having been obtained, and
4. The required fee ( § 1.17(h)).

The petition is **Denied** at this time in that the petition is defective since the requirements set forth in 37 C.F.R. 5.25(a)(3)(iii) have not been met.

The previous denial is maintained. The verified statement fails to provide a clear explanation as to how the foreign application was filed abroad with out error and deceptive intent. Merely stating that it was filed without error and deceptive intent is an insufficient presentation of the facts. Also, an attempt to meet a filing date deadline does not constitute support that it was

filed with out error or deceptive intent.

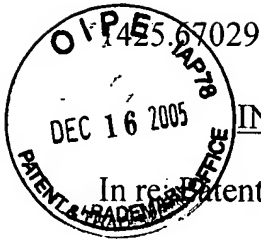
How was the error discovered? How did the error occur? The verified statement should include a statement, coming from the person that was authorized to file abroad, that he/she filed before receiving the foreign filing license because e.g. he/she forgot about the requirement or was unaware of the requirement or U.S. practices.

Accordingly, the provisions of 37 CFR 5.25 not having been fully met, the petition is denied, and in the absence of any response within **60 days** of the mailing date of this letter, such denial will be made final and the final action under 35 U.S.C. 185 will be taken. Extensions of time may be had under 37 C.F.R. 1.136(a).



Andrea M. Valenti  
Patent Examiner  
Group 3643  
(571)272-6895

09 November 2005



PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re: Patent Application of )

Applicant: Jack K. Hosking et al. )

Serial No.: 10/689,452 )

Filed: October 20, 2003 )

For: RAIL FASTENER DRIVER )  
WITH ENHANCED )  
FASTENER POSITIONING )

Art Unit: 3617 )

Examiner: Mark T. Le )

) I hereby certify that this paper is being deposited with the  
) United States Postal Service as FIRST-CLASS mail in an  
) envelope addressed to: Mail Stop Petition;  
) Commissioner for Patents, P.O. Box 1450, Alexandria,  
) VA 22313-1450, on this date.

) Dec. 13, 05

) Date

Attorney for Applicant(s)  
Registration No. 31,497

**RECEIVED**

DEC 20 2005

**LICENSING & REVIEW**

**RESUBMITTED PETITION FOR RETROACTIVE  
FOREIGN FILING LICENSE PURSUANT TO 37 C.F.R. § 5.25**

Mail Stop Petition  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

This paper is in response to the Decision mailed November 25, 2005 in the above-identified application. Applicant's Attorney respectfully petitions for reconsideration of the Denial of the earlier filed Petition and for a retroactive foreign filing license in the above-identified application. Applicant's undersigned Attorney inadvertently caused the above-identified application to be filed in Canada on October 20, 2003 without the grant of a foreign filing license. The undersigned, having first hand knowledge of the facts, hereby states that the filing of the Canadian application occurred through error and without

deceptive intent. The fee in the amount of \$130.00 as required by 37 C.F.R. § 1.17(h) was previously submitted.

The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001, and that such willful false statements may jeopardize the validity of the application or any resulting patent grant, declares that he is properly authorized to execute this application on behalf of the Applicant; and that all statements made of his own knowledge are true, and statements made on information and belief are believed to be true.

Applicant's Attorney states that:

(a) The corresponding foreign application was filed in Canada on October 20, 2003.

(b) The subject matter in question was not under a secrecy order at the time it was filed in Canada, and the subject matter in question is not currently under a secrecy order.

(c) Applicant's Attorney diligently sought a license after discovery of the proscribed foreign filing by submitting herewith a petition for retroactive license shortly after receiving the report from the Canadian foreign associate regarding the Canadian filing.

(d) Applicant's Attorney filed in Canada through error, and without deceptive intent, without the required license under 37 C.F.R. § 5.11 first having been obtained, as Applicant's Attorney inadvertently forgot about the requirement. The facts supporting the conduct that constitutes error without deceptive intent are as follows:

a. Nordco Inc. is the Applicant of the above-identified application.

b. B. Straub, Vice President of Engineering at Nordco Inc., contacted Applicant's Attorney on September 24, 2003, disclosed the subject matter that is the invention of the above-identified application to Applicant's Attorney, and notified Applicant's Attorney that field testing of the subject matter of the above-identified application commenced on or about October 21, 2002.

c. Between September 24, 2003 and October 20, 2003, Applicant's Attorney prepared the application for filing in the United States and Canada.

d. Between September 24, 2003 and October 20, 2003, Applicant's Attorney inadvertently forgot about the requirement to obtain a foreign filing license from the United States Patent and Trademark Office.

e. On October 17, 2003, Applicant's Attorney mistakenly instructed, via e-mail with the order letter attached, the Canadian foreign associate, Mr. Alain Bourassa of the firm Perley-Robertson, Hill & McDougall LLP, located at 90 Sparks Street, Ottawa Ontario, K1P 1E2, Canada, to prepare and file immediately and upon final confirmation, but no later than October 20, 2003, an application in Canada based on the above-identified U.S. Patent Application, also filed on October 20, 2003, in which there was no Serial Number or foreign filing license.

f. Applicant's Attorney mistakenly instructed the Canadian foreign associate to file no later than October 20, 2003 in order to meet the Canadian requirements for filing within a year of the invention being publicly disclosed, and accordingly forgot about the requirement to obtain a foreign filing license before submitting these instructions.

g. The legal assistant to the Canadian foreign associate, Maureen Choo, acknowledged receipt of the instructions on October 20, 2003.

h. Applicant's Attorney sent confirmation regarding final approval of the specification to the Canadian foreign associate on October 20, 2003.

i. The Canadian foreign associate filed the application in the Canadian Patent Office on October 20, 2003.

j. Applicant's Attorney filed an application on the same subject matter in the United States Patent and Trademark Office on October 20, 2003.

k. The Canadian foreign associate reported the filing of the Canadian application to Applicant's Attorney on October 20, 2003, which was received by Applicant's Attorney on October 27, 2003.

Applicant's Attorney asserts that error without deceptive intent was committed in filing the application in Canada on the same day the application was filed in the United States, as Applicant's Attorney inadvertently forgot about the foreign filing license requirement. This error was inadvertently made by Applicant's Attorney and was made by mistake and without deceptive intent.

Enclosed are the following documents and fees:

(i) Petition fee pursuant to 37 C.F.R. § 1.17(h) for retroactive license in the amount of \$130 (previously submitted);



(ii) A copy of the e-mail, dated October 17, 2003, and the attached order letter to the Canadian foreign associate regarding instructions for filing the application in Canada.

(iii) A copy of two e-mails, both dated October 20, 2003, from the legal assistant to the Canadian foreign associate confirming receipt of instructions.

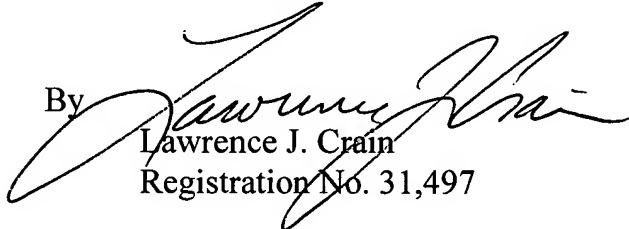
(iii) A copy of the report letter to Applicant's Attorney, dated October 20, 2003, including a copy of the Canadian application.

The Commissioner is authorized by the undersigned to charge any additional fees which may be required to this application, or credit any overpayment, to Deposit Account No. 07-2069. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 07-2069. A duplicate of this Petition is enclosed.

Respectfully submitted,

GREER, BURNS & CRAIN, LTD.

By



Lawrence J. Crain  
Registration No. 31,497

December 13, 2005

300 South Wacker Drive  
Suite 2500  
Chicago, Illinois 60606  
Telephone: (312) 360-0080  
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Customer No. 24978

P:\DOCS\1425\67029\9R5705.DOC





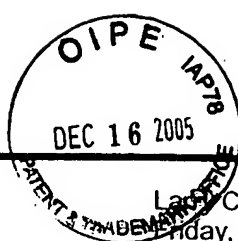
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Examiner: Mark T. Le

Dec. 13, 2007   
Date Attorney for Applicant(s)  
Registration No. 31,497

Lawrence J. Crain, Reg. No. 31,497

Larry Crain



From: Larry Crain [lcrain@gbclaw.net]  
Sent: Friday, October 17, 2003 5:37 PM  
To: Alain Bourassa (E-mail)  
Cc: Morine Choo (E-mail); Vivian DelaRosa (E-mail)  
Subject: URGENT, FILING DUE ON OCT. 20, 2003; Our file 1425.67029

Importance: High

Dear Alain:

Enclosed is the application we discussed. Please wait for final confirmation from us before filing on Monday. Also, please confirm receipt of this e-mail.

Best personal regards,

Larry



ordltr.pdf



CA App.doc



Rev FIGs. 1-6.pdf

Lawrence Crain  
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**GREER, BURNS & CRAIN, LTD.**

*Attorneys at Law*

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BRITTANY C. MACDONALD  
ARIK B. RANSON  
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LAURA R. WANKE  
CHARLES C. CLAUNCH<sup>1</sup>

MICHAEL J. BERGNACH  
ROBERT M. PATINO  
THOMAS S. GRZESIK  
BRIAN J. SLOSSON  
PATENT AGENTS

OF COUNSEL:  
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\*ADMITTED IN CALIFORNIA AND ILLINOIS  
†ADMITTED IN TEXAS ONLY

WRITER'S DIRECT DIAL  
(312) 987-4002  
WRITER'S E-MAIL ADDRESS  
LCRAIN@GBCLAW.NET

October 17, 2003

BY E-MAIL &  
FACSIMILE

Mr. Alain Bourassa  
Perley-Robertson, Hill & McDougall LLP  
90 Sparks Street  
Ottawa, Ontario K1P 1E2  
CANADA

URGENT!!!

Re: New Canadian Patent Application  
corresponding to: U.S. Application Serial No. Unassigned  
Filed: October 20, 2003  
entitled: RAIL FASTENER DRIVER WITH  
ENHANCED FASTENER POSITIONING  
Our File No.: 1425.67029

Dear Alain:

Please prepare and **immediately** file an application in Canada based on the above-identified U.S. Patent Application filed October 20, 2003 in which we do not yet have a Serial No. and no later than **October 20, 2003**.

**PLEASE NOTE THAT WE HAVE NOT YET RECEIVED FINAL APPROVAL OF THE SPECIFICATION, BUT EXPECT THAT BY EARLY MONDAY MORNING, OCT. 20. DO NOT FILE THE APPLICATION UNTIL WE SEND YOU FINAL CONFIRMATION.**

The inventors' names and addresses are as follows:

1. Jack K. Hosking  
1821 Ruben Drive  
Waukesha, Wisconsin 53186, U.S.A  
citizen of the United States of America
2. Robert C. Claes  
211 Cottrell Drive  
Saukville, Wisconsin 53080, U.S.A  
citizen of the United States of America
3. James W. Fuerst  
2434 N. 86<sup>th</sup> Street  
Wauwatosa, Wisconsin 53226, U.S.A  
citizen of the United States of America

The assignee/applicant, by deed of Assignment is as follows:

NORDCO INC.  
182 West Oklahoma Avenue  
Milwaukee, Wisconsin 53207, U.S.A  
a corporation of the State of Delaware

William D. Straub, Vice President of Engineering, is their designated corporate representative.

Based on: U.S. Patent Application No. Unassigned  
Filed: October 20, 2003  
Title: **RAIL FASTENER DRIVER WITH  
ENHANCED FASTENER POSITIONING**

Based on the above, a priority claim is not deemed necessary.

You are authorized to make any formal corrections to the specification and/or claims, which may be required to place the case in condition for filing.

**Enclosures:** 1 copy of specification

1 set of informal drawings

Formal Documents will follow

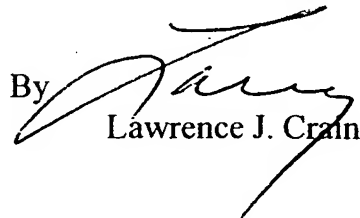
Please advise us of what formal documents we will need for the filing in your country.

- Remarks:**
- 1) Please acknowledge receipt immediately of these instructions by facsimile and indicate whether any additional papers are required at this time.
  - 2) Use FIG. 3 for publication, if applicable.
  - 3) Please keep this case in force in the absence of our instructions to the contrary.
  - 4) Please send all correspondence to the above-indicated address and note our reference number in all future correspondence.

Best personal regards,

GREER, BURNS & CRAIN, LTD.

By



Lawrence J. Crain

LJC:ved

Encls.

K:\1425\67029\CANADA\Canadian ord ltr.doc

**Vivian Delarosa**

---

**From:** Morine Choo [mchoo@perlaw.ca]  
**Sent:** Monday, October 20, 2003 8:09 AM  
**To:** lcrain@gbclaw.net  
**Subject:** Re: URGENT, FILING DUE ON OCT. 20, 2003; Your file 1425.67029

**New Canadian Patent Application**

**Applicant:** Nordco Inc.  
**Inventors:** HOSKING, Jack K.; CLASS, Robert C.; FUERST, James W.  
**Title:** RAIL FASTENER DRIVER WITH ENHANCED FASTENER POSITIONING  
**Your Reference:** 1425.67029  
**Our File:** GBCR-020PCA

We acknowledge receipt of your e-mail instructions of October 17, 2003 to file the above-identified application today, October 20, 2003, pending receipt of confirmation from you to proceed.

We note that there is no need to claim priority, since the corresponding U.S. application is also being filed today. Upon receipt of your instructions to proceed, we will file the application as a large entity, since we note from previous applications filed in the name of Nordco Inc., that they do not qualify for small entity status in Canada. Unless immediately advised by you to the contrary, we will also request examination at the time the application is filed.

We thank you for entrusting this matter to us and await your instructions to proceed with the filing of the application.

Regards.

Morine Choo  
Legal Assistant to Alain D. Bourassa  
Perley-Robertson, Hill & McDougall LLP  
e-mail: mchoo@perlaw.ca  
Telephone No. (613) 238-2022 (Ext. 136)  
Fax: (613) 238-3684

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**Vivian Delarosa**

---

**From:** Morine Choo [mchoo@perlaw.ca]  
**Sent:** Monday, October 20, 2003 10:09 AM  
**To:** lcrain@gbclaw.net  
**Cc:** vdelarosa@gbclaw.net  
**Subject:** Re: URGENT NEW FILING DUE TODAY!!!; Your File 1425.65911 - OurFile: GBCR020

We acknowledge receipt of your instructions and will proceed with the filing of the application today, October 20, 2003.

Regards.

Morine Choo  
Legal Assistant to Alain D. Bourassa  
Perley-Robertson, Hill & McDougall LLP  
e-mail: mchoo@perlaw.ca  
Telephone No. (613) 238-2022 (Ext. 136)  
Fax: (613) 238-3684

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**Avis de confidentialité**

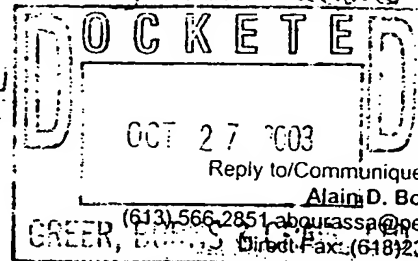
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PERLEY-ROBERTSON, HILL & McDOUGALL LLP

Lawyers / Patent & Trade-Mark Agents  
Avocats / Agents de brevets et de marques de commerce

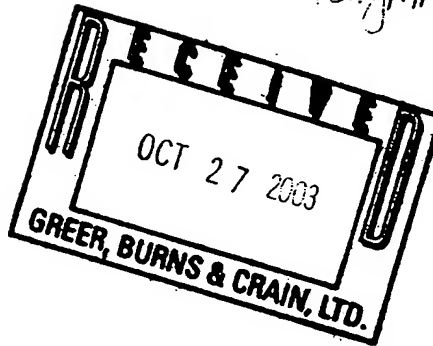
STATUS, PENDING  
GNDM 10150105  
STATUS, PENDING ACTION REQUIRED



File Assignment 1-15-04

October 20, 2003

Lawrence J. Crain  
Greer, Burns & Crain  
Suite 300, South Wacker Drive  
Chicago, IL 60606  
U.S.A.



03 OCT 27 AM 9:33

Dear Larry:

Re: New Canadian Patent Application  
Inventors: HOSKING, Jack K.; CLAAS, Robert C.; FUERST, James W.  
Applicant: Nordco Inc.  
RAIL FASTENER DRIVER WITH ENHANCED FASTENER POSITIONING  
Your Reference: 1425.67029  
Our Reference: GBCR-020PCA

Thank you for your letter of October 17, 2003 and accompanying application materials, providing information for filing the above-captioned case in Canada. We also acknowledge your e-mail instructions of October 20, 2003 advising of the correct spelling of the name of inventor Robert C. Claas.

We are pleased to report that the application was hand-filed in the Canadian Patent Office today. Duplicate copies of the Petition, Abstract, Description, Claims, Drawings and our covering letter to the Commissioner of Patents as filed are enclosed. In approximately twelve to fourteen weeks time, we will receive and forward to you the filing certificate which will confirm today's filing date and also provide the serial number allotted this application. The application will be available for public inspection eighteen months from this date.

Annual maintenance fees must be paid to prevent the application from becoming abandoned. The first maintenance fee is payable between the first and second anniversaries of the date of



PERLEY-ROBERTSON, HILL & McDOUGALL LLP

Lawrence J. Grant  
October 20, 2003

filing. The first annuity on this application falls due on **October 20, 2005** and annually thereafter. Failure to make a timely maintenance fee payment against a pending patent application will result in it being deemed abandoned.

Since we did not receiving your instructions to the contrary, a request for examination was filed with the application as you will note from our covering letter to the Commissioner of Patents.

Under Canadian practice, it will be necessary to file a recordable title document in favour of the applicant. It is suggested you forward it to us as soon as possible, as otherwise it will be requisitioned by the Patent Office and unless timely filed, could result in abandonment of this case. While the Patent Office will now accept a copy of a transfer instrument for recordal purposes, at a minimum, and on its face, the signature of a subscribing witness should appear. In the event a suitable assignment is not available, we have prepared and enclose an assignment for signature by each of the three inventors. The enclosed assignment should be signed before a witness and the signature of each witness should also appear on the assignment above the "Witness" signing line. The date of signing must also be inserted.

We thank you for entrusting the matter to us.

Our debit note is enclosed.

Yours very truly,

Alain D. Bourassa

ADB:mc  
Encls.



COPY

PERLEY-ROBERTSON, HILL & McDOUGALL LLP

*Lawyers / Patent & Trade-Mark Agents  
Avocats / Agents de brevets et de marques de commerce*

Reply to/Communiquez avec:  
Alain D. Bourassa  
(613) 566-2851 abourassa@perlaw.ca  
Direct Fax: (613)238-3684

October 20, 2003

The Commissioner of Patents,  
Ottawa-Hull, Canada.

Dear Sir:

Re: New Canadian Patent Application  
Inventors: HOSKING, Jack K.; CLAAS, Robert C.; FUERST,  
James W.  
Applicant: Nordco Inc.  
RAIL FASTENER DRIVER WITH ENHANCED FASTENER POSITIONING  
Our Reference: GBCR-020PCA

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In support of the above, we enclose:

1. Petition;
2. Abstract;
3. Description consisting of pages 1 to 11;
4. Claims comprising claims 1 to 21;
5. Drawings, comprising:  
6 sheets and 6 Figures;

Our remittance of today's date includes the below listed sum, calculated as follows:

Filing Fee(Large entity)	\$300.00
Examination fee (Large entity)	\$400.00
Total	\$700.00

**EXAMINATION REQUEST**

We also request that the application as identified herein be made the subject of examination.



PERLEY-ROBERTSON, HILL & McDOUGALL LLP

COPY

The Commissioner of Patents  
October 20, 2003

Our remittance of today's date also includes the sum of \$400.00 for the prescribed examination fee as set out above.

**ASSIGNMENT**

An assignment in favour of the applicant is not available for filing at this time, but will be submitted as soon as it becomes available.

Yours very truly,

PERLEY-ROBERTSON,  
HILL & McDOUGALL LLP

Per: Alain D. Bourassa

ADB:mc  
Encls.

UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
10/689,452	15-Sep-04	JACK HOSKING, ET AL.	1425.67029

Title: RAIL FASTENER DRIVER WITH ENHANCED  
FASTENER POSITIONING

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Art Unit	Paper Number
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Correspondence Address:

LAWRENCE J. CRAIN  
GREER, BURNS & CRAIN, LTD.  
300 SOUTH WACKER DRIVE  
SUITE 2500  
CHICAGO, ILL. 60606

PATENT & TRADEMARK OFFICE  
**MAILED**

NOV 25 2005

LICENSING & REVIEW

Please find attached a communication from the Examiner regarding the  
Petition for Retroactive License under 37 CFR 5.25.



UNITED STATES PATENT AND TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND  
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE  
WASHINGTON, DC 20231  
www.uspto.gov

Lawrence J. Crain  
GREER, BURNS & CRAIN, LTD.  
300 South Wacker Drive  
Suite 2500  
Chicago, IL 60606

In re: Hosking et al : DECISION ON REQUEST  
Serial No.: ~~10/689,462~~ 10/689,452 : UNDER 37 CFR 5.25  
Filing date: 20 October 2003  
Docket No: 1425.67029

Title: RAIL FASTENER DRIVER WITH ENHANCED FASTENER POSITIONING

This is a decision on the petition response filed 11 April 2005 for the petition for retroactive foreign filing license filed on 16 September 2004 and subsequent to the decision mailed 22 March 2005.

37 CFR 5.25(a) requires the following:

1. A listing of each of the foreign countries in which the unlicensed patent application material was filed,
2. The dates on which the material was filed in each country,
3. A verified statement (oath or declaration) containing:
  - i. An averment that the subject matter in question was not under a secrecy order at the time it was filed abroad, and that it is not currently under a secrecy order,
  - ii. A showing that the license has been diligently sought after discovery of the proscribed foreign filing, and
  - iii. An explanation of why the material was filed abroad through error and without deceptive intent without the required license under § 5.11 first having been obtained, and
4. The required fee ( § 1.17(h)).

The petition is **Denied** at this time in that the petition is defective since the requirements set forth in 37 C.F.R. 5.25(a)(3)(iii) have not been met.

The previous denial is maintained. The verified statement fails to provide a clear explanation as to how the foreign application was filed abroad with out error and deceptive intent. Merely stating that it was filed without error and deceptive intent is an insufficient presentation of the facts. Also, an attempt to meet a filing date deadline does not constitute support that it was

filed with out error or deceptive intent.

How was the error discovered? How did the error occur? The verified statement should include a statement, coming from the person that was authorized to file abroad, that he/she filed before receiving the foreign filing license because e.g. he/she forgot about the requirement or was unaware of the requirement or U.S. practices.

Accordingly, the provisions of 37 CFR 5.25 not having been fully met, the petition is denied, and in the absence of any response within **60 days** of the mailing date of this letter, such denial will be made final and the final action under 35 U.S.C. 185 will be taken. Extensions of time may be had under 37 C.F.R. 1.136(a).



Andrea M. Valenti  
Patent Examiner  
Group 3643  
(571)272-6895

09 November 2005



UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
10/689,452	15-Sep-04	JACK HOSKING, ET AL.	1425.67029

Title: RAIL FASTENER DRIVER WITH ENHANCED  
FASTENER POSITIONING

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Art Unit	Paper Number
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Correspondence Address:

LAWRENCE J. CRAIN  
GREER, BURNS & CRAIN, LTD.  
300 SOUTH WACKER DRIVE  
SUITE 2500  
CHICAGO, ILL. 60606

PATENT & TRADEMARK OFFICE  
**MAILED**

MAR 22 2005

LICENSING & REVIEW

Please find attached a communication from the Examiner regarding the  
Petition for Retroactive License under 37 CFR 5.25.



UNITED STATES PATENT AND TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND  
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE  
WASHINGTON, DC 20231  
www.uspto.gov

Lawrence J. Crain  
GREER, BURNS & CRAIN, LTD.  
300 South Wacker Drive  
Suite 2500  
Chicago, IL 60606

In re:            Hosking et al                                :        DECISION ON REQUEST  
Serial No.:     10/689,462                                :        UNDER 37 CFR 5.25  
Filing date:    30 January 2004  
Docket No:     1425.67029

Title: RAIL FASTENER DRIVER WITH ENHANCED FASTENER POSITIONING

This is a decision on the petition filed on 30 January 2004 for a retroactive foreign filing license.

37 CFR 5.25(a) requires the following:

1. A listing of each of the foreign countries in which the unlicensed patent application material was filed,
2. The dates on which the material was filed in each country,
3. A verified statement (oath or declaration) containing:
  - i. An averment that the subject matter in question was not under a secrecy order at the time it was filed abroad, and that it is not currently under a secrecy order,
  - ii. A showing that the license has been diligently sought after discovery of the proscribed foreign filing, and
  - iii. An explanation of why the material was filed abroad through error and without deceptive intent without the required license under § 5.11 first having been obtained, and
4. The required fee ( § 1.17(h)).

The petition is **Denied** at this time in that the petition is defective since the requirements set forth in 37 C.F.R. 5.25(a)(3)(iii) have not been met.

The verified statement fails to provide a clear explanation as to how the foreign application was filed abroad with out error and deceptive intent. Merely stating that it was filed without error and deceptive intent is an insufficient presentation of the facts. Also, an attempt to meet a filing date deadline does not constitute support that it was filed with out error or deceptive intent.

Accordingly, the provisions of 37 CFR 5.25 not having been fully met, the petition is denied, and in the absence of any response within **60 days** of the mailing date of this letter, such denial will be made final and the final action under 35 U.S.C. 185 will be taken. Extensions of time may be had under 37 C.F.R. 1.136(a).

A handwritten signature in cursive script that reads "Andrea M. Valenti".

Andrea M. Valenti  
Patent Examiner  
Group 3643  
(703) 305-3010

21 December 2004



125.67029

## PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re: Patent Application of )

Applicant: Jack K. Hosking et al. )

Serial No.: 10/689,452 )

Filed: October 20, 2003 )

For: RAIL FASTENER DRIVER )  
WITH ENHANCED )  
FASTENER POSITIONING )

Art Unit: Unassigned )

Examiner: Unassigned )

I hereby certify that this paper is being deposited with the  
United States Postal Service as FIRST-CLASS mail in an  
envelope addressed to: Commissioner for Patents, P.O.  
Box 1450, Alexandria, VA 22313-1450, on this date.

December 22, 2003

Date

*Lawrence A. Chan*  
Attorney for Applicant(s)  
Registration No. 31,497

RECEIVED

SEP 15 2004

LICENSING &amp; REGISTRATION

**PETITION FOR RETROACTIVE LICENSE  
PURSUANT TO 37 C.F.R. § 5.25**

Mail Stop Petition  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

Applicant's Attorney respectfully petitions for retroactive license in the above-identified application. Applicant's undersigned Attorney caused the above-identified application to be filed in Canada on October 20, 2003 without the grant of a foreign filing license. The undersigned, having first hand knowledge of the facts, hereby states that the filing of the Canadian application occurred through error and without deceptive intent. As required by 37 C.F.R. § 1.17(h), the fee for petition of \$130 is enclosed herewith.

The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001, and that

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such willful false statements may jeopardize the validity of the application or any resulting patent grant, declares that he is properly authorized to execute this application on behalf of the Applicant; and that all statements made of his own knowledge are true, and statements made on information and belief are believed to be true.

Applicant's Attorney states that:

(a) The corresponding foreign application was filed in Canada on October 20, 2003.

(b) The subject matter in question was not under a secrecy order at the time it was filed in Canada, and the subject matter in question is not currently under a secrecy order.

(c) Applicant's Attorney diligently sought a license after discovery of the proscribed foreign filing by submitting herewith a petition for retroactive license shortly after receiving the report from the Canadian foreign associate regarding the Canadian filing.

(d) Applicant's Attorney filed in Canada through error, and without deceptive intent, without the required license under 37 C.F.R. § 5.11 first having been obtained. The facts supporting the conduct that constitutes error without deceptive intent are as follows:

- a. Nordco Inc. is the Applicant of the above-identified application.
- b. B. Straub, Vice President of Engineering at Nordco Inc., contacted Applicant's Attorney on September 24, 2003, disclosed the subject matter that is the invention of the above-identified application to Applicant's Attorney, and notified

Applicant's Attorney that field testing of the subject matter of the above-identified application commenced on or about October 21, 2002.

c. Between September 24, 2003 and October 20, 2003, Applicant's Attorney prepared the application for filing in the United States and Canada.

d. Between September 24, 2003 and October 20, 2003, Applicant's Attorney failed to obtain a foreign filing license from the United States Patent and Trademark Office.

e. On October 17, 2003, Applicant's Attorney instructed, via e-mail with the order letter attached, the Canadian foreign associate, Mr. Alain Bourassa of the firm Perley-Robertson, Hill & McDougall LLP, located at 90 Sparks Street, Ottawa Ontario, K1P 1E2, Canada, to prepare and file immediately and upon final confirmation, but no later than October 20, 2003, an application in Canada based on the above-identified U.S. Patent Application, also filed on October 20, 2003, in which there was no Serial Number or foreign filing license.

f. Applicant's Attorney instructed the Canadian foreign associate to file no later than October 20, 2003 in order to meet the Canadian requirements for filing within a year of the invention being publicly disclosed. Section 28.2 (1)(a) of the Canadian Patent Act requires that the subject-matter defined by a claim in an application for a patent in Canada must not have been disclosed more than one year before the filing date by the applicant, or by a person who obtained knowledge, directly or indirectly, from the applicant, in such a manner that the subject-matter became available to the public in Canada or elsewhere;

g. The legal assistant to the Canadian foreign associate, Maureen Choo, acknowledged receipt of the instructions on October 20, 2003.

h. Applicant's Attorney sent confirmation regarding final approval of the specification to the Canadian foreign associate on October 20, 2003.

i. The Canadian foreign associate filed the application in the Canadian Patent Office on October 20, 2003.

j. Applicant's Attorney filed an application on the same subject matter in the United States Patent and Trademark Office on October 20, 2003.

k. The Canadian foreign associate reported the filing of the Canadian application to Applicant's Attorney on October 20, 2003, which was received by Applicant's Attorney on October 27, 2003.

Applicant's Attorney asserts that error without deceptive intent was committed in filing the application in Canada on the same day the application was filed in the United States, therefore not enabling adequate time for a foreign filing license to be granted by the United States Patent and Trademark Office. Applicant's Attorney further asserts that Canadian Patent Law necessitated filing the application in Canada on October 20, 2003 in order to avoid Applicant's loss of rights due to the possible disclosure of the invention on October 21, 2002.

Enclosed are the following documents and fees:

(i) Petition fee pursuant to 37 C.F.R. § 1.17(h) for retroactive license in the amount of \$130;

(ii) A copy of the e-mail, dated October 17, 2003, and the attached order letter to the Canadian foreign associate regarding instructions for filing the application in Canada.

(iii) A copy of two e-mails, both dated October 20, 2003, from the legal assistant to the Canadian foreign associate confirming receipt of instructions.

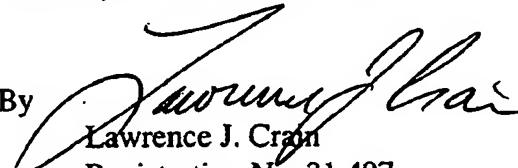
(iii) A copy of the report letter to Applicant's Attorney, dated October 20, 2003, including a copy of the Canadian application.

The Commissioner is authorized by the undersigned to charge any additional fees which may be required to this application, or credit any overpayment, to Deposit Account No. 07-2069. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 07-2069. A duplicate of this Petition is enclosed.

Respectfully submitted,

GREER, BURNS & CRAIN, LTD.

By

  
Lawrence J. Crain  
Registration No. 31,497

December 22, 2003

300 South Wacker Drive  
Suite 2500  
Chicago, Illinois 60606  
Telephone: (312) 360-0080  
Facsimile: (312) 360-9315  
Customer No. 24978

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